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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,230	12/03/2001	Takeshi Utsunomiya	35.G2946	5081
5514	7590	01/26/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			DIVINE, LUCAS	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2624	
DATE MAILED: 01/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,230

Applicant(s)

UTSUNOMIYA, TAKESHI

Examiner

Lucas Divine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 37 – 54 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 37 – 54 have been considered but are moot in view of the new ground(s) of rejection.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, **the a setting file that includes information to designate a print file** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 37, 38, 40, 43, 44, 46, 49, 50, and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Hansen (US 6509974).

Regarding claims 37, 43, and 49, Hansen teaches a printer comprising:

a receiving unit (e.g. 114, 116, which can receive the set up orders) **for receiving an electronic mail** (col. 3 line 45) **including a setting file** (print tickets/print settings files, Fig. 4 includes examples 438 and the print settings file for document 6) **for setting a format** (438, Fig. 4 as well as col. 6 lines 25-30, 45-60, col. 11 lines 30-40 – line col. 11 line 321 specifically states setting page formatting, col. 2 line 25 'predefined format') **and a print file** (document content for printing, e.g. 434, Fig. 4 and content under document 6),

wherein the setting file includes information to designate the print file (e.g. the D6 after print settings of document 6, col. 12 line 24, wherein the tickets/print settings are associated with documents/print files); and

a printing unit (122, Fig. 1b) for printing the print file, designated by the setting file, in the format set by the setting file (order is carried about as set by the associated job tickets/print settings – fulfillment stage 110).

Regarding claims 38, 44, and 50, which depend from claims 37, 43, and 49, Hansen teaches **wherein the print file includes a plurality of print files** (Fig. 4, multiple 434's).

Regarding claims 40, 46, and 52, which depend from claims 37, 43, and 49, Hansen teaches **wherein the setting file designates the print file to be printed by an order of the print file** (col. 2 line 38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 39, 45, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen.

Regarding claims 39, 45, and 51, which depend from claims 37, 43, and 49, Hansen teaches **wherein the setting file designates the print file to be printed by a name of the print file** (the D6 of the name of the print settings file is a designation of the print content/file it is

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associated with). It would have been obvious to one of ordinary skill that the GUI of Fig. 4 would include being able to rename the files for most correctly preparing the book. Hansen states in col. 9 lines 5-13 that the GUI is one as standard in the art, which obviously would include the rename function. For example, since the example of Hansen is generating books with multiple setting files and print files, it would have been obvious to one of ordinary skill in the art that a user may want to set Document 6 renamed as 'Chapter 2' or some other book type designation, which then could be set for the print and setting files.

6. Claims 41, 47, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen as applied to claims 37, 43, and 49 above, and further in view of Kimoto (US 6792577).

Regarding claims 41, 47, and 53, which depend from claims 37, 43, and 49, Hansen teaches a online printing system that is connected with the Internet to allow a user to print any content they wish, but Hansen does not specifically teach that the print settings and content data are a style sheet and HTML, respectively.

However, Kimoto teaches that style sheets and HTML can be used as separate files that are used to create a final document for printing (col. 16 lines 42-47, Fig. 5, Fig. 6, Fig. 8, Fig. 9, Fig. 17). This is well known printing in the art and functions very similar to setting print settings and using them to format the content for printing as done in Hansen. And thus, since Hansen is an Internet printing system:

It would have been obvious to one of ordinary skill in the art that one type of content and print settings type would have been HTML and style sheets. The motivation for allowing such

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types are to allow very common types of formatting and content to be printed in an online printing system.

7. Claims 42, 48, and 54 rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen as applied to claims 37, 43, and 49 above, and further in view of L'Heureux et al. (US 6697942).

Regarding claims 32, 48, and 54, which depend from claims 37, 43, and 49, Hansen teaches a system of submitting a job, including print files and setting files, to the printer system via email (wherein email inherently includes a message body), but Hansen does not specifically teach how the email is set up to submit that job, and thus does not specifically teach **a message body the includes information to designate the setting file and the print file.**

However, L'Heureux teaches a system where an email can be used to control a remote device including specifying all of the command (including designations) and content information in the message body (Fig. 12 and associated discussions).

It would have been obvious to one of ordinary skill in the art that command/order information could be included in an email. Thus, the system of Hansen and L'Heureux would have been able to include the order information of the job as well as any or all content of the system in the email itself. The motivation for doing so would have been to be able to have an all automated system by controlling the printing system from the email itself. Another motivation would have been to not have the files be as attachments, thus possibly preventing the system from being caught by attachment filters and virus filters and attachment size filters accidentally.

Conclusion

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8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Lucas Divine

Examiner

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A handwritten signature in black ink, appearing to read 'K. Y. Poon', with a stylized flourish at the end.

KING Y. POON
PRIMARY EXAMINER